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508 East 5th Street
Bethlehem PA 18015

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OFFICE OF PETITIONS

In re Application of :
William Delaplaine Green :
Application No. 10/637,841 : DECISION ON PETITION
Filed: August 8, 2003 : PURSUANT TO
Title: TWO-CYCLE INTERNAL : 37 C.F.R. § 1.137(A)
COMBUSTION ENGINE :

This is a decision on the petition filed December 21, 2010, pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application.

This petition is **DISMISSED**.

BACKGROUND

An Office communication (first Office communication) was mailed on December 17, 2009, which required, *inter alia*, the submission of a marked up copy of a substitute specification. The mailing set a non-extendable one month period for response, and expressly withdrew a previously-made indication from the Office that the application contains allowable claims.¹ A response was received on January 19, 2010, and a marked up copy of the substitute specification was not submitted concurrently therewith. Consequently, an Office communication (second Office communication) was mailed on February 25, 2010, which reiterated the requirement for the submission of a marked up copy of a substitute specification. The second Office communication set an extendable one month period for response. No extensions of time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-

¹ See first Office communication, page 2. See also Office Action Summary of December 21, 2006, section 5.

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identified application became abandoned on March 26, 2010. A notice of abandonment was mailed on October 28, 2010.

RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

The Applicable Standard

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard:

In the specialized field of patent law...the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference.²

2 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), *aff'd* without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); *see also* Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific

Decision on Petition pursuant to 37 C.F.R. § 1.137(a)

[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense.³

The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'⁴

The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.⁵

The burden of showing the cause of the delay is on the person seeking to revive the application.⁶

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

3 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

4 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. § 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

5 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

6 Id.

7 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

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In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

As such, the general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."⁸

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."⁹

ANALYSIS

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition pursuant to 37 C.F.R. § 1.137(a), Petitioner has included the petition fee and a statement of facts.

The second requirement of Rule 1.137(a) has been met. The fourth requirement of Rule 1.137(a) is not applicable, as a terminal disclaimer is not required.¹⁰ The first and third requirements have not been satisfied, as will now be pointed out.

Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply

⁸ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

⁹ Haines v. Quigg, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

¹⁰ See Rule 1.137(d).

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to the second Office communication. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.¹¹ In order for the application to be revived, Petitioner must submit a reply that satisfies 37 C.F.R.

§ 1.137(a)(1) (i.e., a marked up copy of the substitute specification). The petition was not accompanied by this reply.

Regarding the third requirement, with this petition pursuant to 37 C.F.R. § 1.137(a), Petitioner has not explained why he failed to respond to the second Office communication. It is noted that Petitioner has expressed a suspicion that postal mail is stolen from his residential mailbox on a regular basis. In case he is not in possession of the second Office communication, a courtesy copy of the same has been included with this decision.

Pursuant to 37 C.F.R. § 1.134, the notice clearly set forth the period of time set for reply:

"...applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS (emphasis included) from the mailing date of this letter, whichever is longer, to submit a complete reply."

Notice, page 1.

Petitioner failed to reply within this period of time, and as such, this application became abandoned by operation of law, pursuant to 37 C.F.R. § 1.135.

A reasonable and prudent person, acting in relation to his most important business, would have read the notice, noted the one-month period for response, and submitted a reply within either the original or the extendable period for response. It follows that the record does not support a finding that the entire period of delay was unavoidable.

The present set of facts might result in a finding of unintentional delay, but it does not rise to the level of unavoidable.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Pursuant to 37 C.F.R. § 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C.

¹¹ See MPEP § 711.03(c).

§ 704.

Alternatively, Petitioner may wish to consider filing a petition pursuant to 37 C.F.R. § 1.137(b). Unless Petitioner believes that he can successfully assert that the entire period of delay was unavoidable, he may wish to file pursuant to the unintentional standard.

If Petitioner is in a position to assert that he failed to receive the second Office communication, he should assert as much on renewed petition, and follow the procedure set forth in MPEP § 711.03(c)(I)(A).

Petitioner may download information about these petitions here:
http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03c.htm#sect711.03c

Any subsequent filing pertaining to the abandonment of this application should indicate that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,¹² hand-delivery,¹³ or facsimile.¹⁴ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹⁵

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence

12 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

13 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

14 (571) 273-8300: please note this is a central facsimile number.

15 <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

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Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

/Paul Shanoski/

Paul Shanoski

Senior Attorney

Office of Petitions

Encl. Courtesy copy of the Office communication of February 25, 2010.

cc: William Delaplaine Green
8906 Camden Street
Alexandria, VA 22308-2715